



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/957,494	10/24/97	WILLIAMS	J

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PM52/1209

EXAMINER

SWIA TEK.R

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 12/09/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/957,494

Applicant(s)
Williams

Examiner
Robert P. Swiatek

Group Art Unit
3643



☒ Responsive to communication(s) filed on 24 Oct 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-6 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on 24 Oct 1997 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3643

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it fails to provide an adequate written description of the invention. Figures 2A, 2B, and 4 lack brief descriptions in the section of the specification entitled "Brief Description of the Several Views of the Drawings." Reference numerals 1, 3-10 are each used twice in the specification to refer to two different elements. Each reference numeral must consistently denote only one element throughout the specification. For example, on page 3, line 4, numerals 7, 8 are used to identify side flaps; on page 6, line 2, they are used again to designate foam layers rather than side flaps. In addition, the pages of the specification must be numbered consecutively; reference numeral "11" is not identified in the detailed description of the invention. On page 4, line 12, "proportinate" is a misspelling; on page 5, line 4, it is unclear

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what the term "they" is referring to, in lines 8, 11, reference is made to "inner layers," yet only a single inner layer has been disclosed as being within each pad, in line 23, "dielectrically" is a misspelling; on page 6, line 4, it is unclear what element numeral "9" is referring to, in line 4, numeral "10" is used to identify a "seam point" while in line 5, the numeral "10" denotes a "seam." It is suggested that a substitute specification--correcting the deficiencies noted above--be filed in any response to this action and the originally-filed specification canceled.

The abstract of the disclosure is objected to because it must consist of only a single paragraph. Correction is required. See MPEP § 608.01(b).

The drawings are objected to because numerals 1-9 have each been used to identify two different elements, which is improper. Correction is required. Each numeral should consistently identify a single component throughout the various figures.

Claims 1-6 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited. In claim 1, line 1, use of the term "or" is confusing as it fails to reasonably limit the scope of the invention--the claim must be limited to either a single layer pad (not described or shown as such in the specification or drawings) or a multi-layer, not both. In claim 1, line 3, the phrase

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"extending all layers" is unclear. Applicant should refer to the Arnold reference (5,497,602) for an example of properly-written claims.

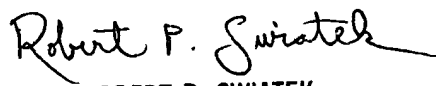
An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

If the claims are amended to overcome the rejection under 35 USC 112, second paragraph, they could be allowable.

The patents to Lee (4,695,496), Gonzales (4,827,701), and Green (5,575,139) have been cited to provide examples of prior art saddle pads.

RPS: ©703/308-2700
25 November 1998--d.10


ROBERT P. SWIATEK
PRIMARY EXAMINER
ART UNIT ~~882~~ 3643